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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,309	03/20/2001	Yuriy Grigorievich Shermolovich	514413-3870	2930

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EXAMINER

FORD, JOHN M

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 01/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/812,309

Applicant(s)

SHERMOLOVICH ET AL.

Examiner

John M>Ford

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1--12 and 15--23 is/are pending in the application.
- 4a) Of the above claim(s) 9--12 and 15--19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1--8 and 20--23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Applicants' response of Dec. 17, 2001, is noted.

The claims in the application are claims 1--12 and 15--23.

Applicants elected Group I, the instances where X is CH, i.e. claims 1--8 and 20--23.

Applicants elected X being CH. Claim 1 need be amended to reflexed that election. A reference to a triazine is not a reference to pyrimidine Note, footnote 7 of In re Harnisch, 206 USPQ 300, provided for such a restriction.

The practice is set forth in footnote 3 of In re Weber 198 USPQ 330, except the claim here is not rejected under 35 U.S.C. 121, it is restricted to one invention per 37 CFR 1.141, as the examiner is no given the time to examine more than one invention per application.

Line 1 is claim 1 need recite or salts thereof, rather than and salts.

Claim 1 is rejected under 35 U.S.C. 112, 2nd paragraph. It is not clear which heterocyclic rings are being claimed in R2, or R4 and R5, together; note In re Wiggins 179 USPQ 421 at 423.

Claim 6 is rejected under 35 U.S.C. 112, 2nd paragraph, what ring is being *claimed?*

What further hetero atoms are intended? Last line of R8.

Also in claim 8, note heterocyclyl, last word in R10. Heterocyclic chemistry is a huge area of chemistry, before the pyridine elected. The USPTO only recognizes N, O, S, Se and Te as hetero atoms. What do applicants intend? What actual rings are being claimed?

R11 in claim 6 is a run-on-sentence that is not understandable. Note the *pr*vious heterocyclyl rejection. R11 is too long to understand.

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In claim 7, a unit SR4R5 is referred to. How is it bonding into formula (I). In A, the Sulphur has a valence form of 2, already satisfied. Therefore claim 7 is rejected under 35 U.S.C. 112, 2nd paragraph.

Claims 9--12 stand withdrawn under 37 CFR 1.142(b) as being directed to non-elected subject matter.

Claims 20--23 are considered the elected methods. Applicants could write proper composition claims for those uses.

The "at least one" in claim 9 is open and could not be accepted here.

The additional active ingredients of claim 11 is clearly outside the invention elected here.

Claims 15--19 stand withdrawn under 37 CFR 1.142 (b), as being outside the invention elected here.

Claims 20--23 are rejected as being dependent on a rejected claimed.

Any claim not specifically rejected, or withdrawn, is rejected as being dependent on a rejected claim. Therefore, not written in an allowable form.

If R1 and R2 of EP 580,374 is S(O)nR, then EP 580,374 reads on claim 1 of the EP under 35 U.S.C. 103 because the other would have to be assumed H and a default to a double bond.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

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Chemical Abstracts vol. 132 entry 60427 (1999) teaches compounds within claim 1 here,  
35 U.S.C. 102/103.

Claim 1 is rejected under 35 U.S.C. 103 in view of CA:132: 60427 (1999) compare the  
species.


Minor variation would be within the skill of one of ordinary skill in the art.

Claim 1 is rejected under 35 U.S.C. 102 in view of CA 132:60427 (1999) compare the  
species of the CA entry to the genus claimed.

J. Ford:jmr

Jan. 10, 2002

Jan. 16, 2002

  
JOHN M. FORD  
PRIMARY EXAMINER  
GROUP - ART UNIT 1624